

**REMARKS**

With this Amendment, Applicant amends Claims 3-8 and adds new Claims 18-25. Therefore, Claims 1-25 are currently pending in the present Application.

**Formalities**

With the current Office Action, the Examiner returns a signed and initialed copy of the PTO-Form 1449 filed with the Applicant's IDS of June 23, 2005.

Applicant notes that the Examiner did not acknowledge Applicant's claim to foreign priority and the receipt of the certified copy of the priority document. Therefore, Applicant respectfully requests that the Examiner make these acknowledgements in the next Office communication.

**Allowable Subject Matter**

The Examiner indicates that Claim 12 contains allowable subject matter and would be allowed if rewritten into independent form, including the limitations of the claims from which it depends. Applicant respectfully requests that the rewriting of this claim be held in abeyance at this time.

**§112, second paragraph**

Claims 4-8 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as his invention. Specifically, the Examiner asserts that the "the step (I) includes" language present in these claims renders the claims indefinite because it "infers the

inclusion of new material to an already existing step,” making the already-existing step redundant.

With this Amendment, Applicant amends Claims 4-8 for purposes of clarity. In view of these amendments, Applicant respectfully requests that the §112 rejection of Claims 4-8 be reconsidered and withdrawn.

Additionally, Applicant notes that Claim 3 has been amended for purposes of clarity.

**New Claims 18-25**

With this Amendment, Applicant adds new Claims 18-25 in order more fully to cover various aspects of Applicants’ invention as disclosed in the specification.

**§103(a)**

Claims 1-3, 9-11, and 17 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Otsuki, U.S. Patent No. 6,700,553 (“Otsuki”), in view of Brenner et al., U.S. Patent No. 6,318,827 (“Brenner”). Claim 13 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Otsuki, in view of Brenner and Wade et al., U.S. Patent No. 6,315,381 (“Wade”). Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Otsuki, in view of Brenner and Fujita et al., U.S. Patent No. 6,491,373 (“Fujita”). Claim 16 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Otsuki, in view of Brenner and Lo et al., U.S. Patent No. 6,268,927 (“Lo”).

Regarding independent Claims 1, 9, and 17, Applicant submits that the cited combination of references fails to teach or suggest a first bi-directional printing mode and a second bi-directional printing mode which use inks in a first set and a second set, respectively, where the

first set and the second set include different combinations of inks, as recited. The Examiner acknowledges that Otsuki fails to teach or suggest this limitation. Regarding Brenner, Applicant notes that Brenner teaches the use of a plurality of ink cartridges, such as a black ink cartridge and three single color ink cartridges (col. 3, lns. 63-67). However, there is no teaching or suggestion in Brenner of different sets of inks including different combinations of inks or any teaching or suggestion of print modes which use different sets of different combinations of inks. The printing modes, as described in Brenner include, for example, a Best mode, a Normal mode, a Draft mode, or a Photo-Best mode (col. 5, ln. 67 to col. 6, ln. 2). As described, depending on which of these modes is selected, it is determined whether the selected mode is a mode in which bi-directional printing is only used if bi-directional alignment has been performed. Thereby, based on which mode is selected and on whether bi-directional alignment has been performed, printing is performed using bi-directional printing or using only single-direction printing (col. 6, lns. 5-47).

Therefore, in view of the above, Applicant submits that the cited combination of references fails to teach or suggest different sets of inks including different combinations of inks or print modes which use different sets of different combinations of inks. Therefore, Applicant submits that independent claims 1, 9, and 17 are patentable over the cited combination of references.

Regarding claims 2, 3, and 10-16 Applicant submits that these claims are patentable at least by virtue of their dependence on claims 1 and 9.

Additionally, regarding claims 15, Applicant submits that none of the cited references teaches or suggests using a position adjustment value “for another bi-directional print mode when the position adjustment value storage does not store the position adjustment value for bi-directional print mode used by the printing apparatus.” The Examiner relies on Fujita to teach this limitation and acknowledges that the other references fail to teach or suggest this limitation. Fujita describes that “if the adjustment value for the O/E registration is stored in the EEPROM [] at the time of shipment, the patterns at the “0” position (default value) are printed with the adjustment value that was set at time of shipment from factory.” The Examiner refers to this description as teaching the limitations of both claim 14 and claim 15 of the present invention. In other words, the Examiner appears to assert that this descriptions teaches both using a present standard value when a position adjustment value is not stored and using a value from another print mode when a position adjustment value is not stored. The Examiner appears to submit that this description teaches both of these limitations because he asserts that “default” is the claimed “another bi-directional print mode.” However, one of skill in the art would not interpret a stored default value to be a bi-directional print mode. Applicant submits that Fujita fails to teach or suggest using a position adjustment value from another bi-directional print mode when no position adjustment value is stored for the bi-directional print mode which is being used. The “default” value that the Examiner refers to is not a position adjustment value for another print mode, rather it is not associated with any print mode.

Regarding claim 16, none of the cited references teaches or suggests outputting a warning when a position adjustment storage does not store a position adjustment value. Regarding this

limitation, the Examiner relies on Lo and acknowledges that this limitation is not taught by the other references. Applicant submits that Lo fails to teach or suggest any such limitation. Lo is generally directed to a method and apparatus for overlying a data image on a form image. It is described that the date image is combined with “an image of a form, such as a business form that is stored in memory on the printer.” (col. 1, lns. 19-21). Figure 1 of Lo illustrates “an exemplary form” (col. 4, lns. 42-46). It is clear from the descriptions in the Lo specification and from the figures that the “form” which is referred to is an image of a document with blank spaces for insertion of required or requested information. Thus, the described “form” is in no way related to the recited “position adjustment value” of claim 16. However, the Examiner relies on Lo, col. 7, lns. 23-26 to teach the claimed limitation. This portion of Lo describes that when a storage device (in which forms are stored) becomes full, “newly downloaded form files are not saved and a warning message is displayed on the display.” The Examiner asserts that “‘form file’ is read as position adjustment value.” (OA, p. 6). However, it is clear from Lo that one of skill in the art would never equate the described form file with a position adjustment value.

Therefore, in view of the above, Applicant respectfully requests that the rejections of Claims 1-3, 9-11, and 13-17 be reconsidered and withdrawn.

### **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

**Amendment Under 37 C.F.R. § 1.111**  
U.S. Application No. 10/674,808

**Attorney Docket No. Q77778**

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

  
\_\_\_\_\_  
Laura Moskowitz  
Registration No. 55,470

Date: October 24, 2005